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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,515	06/18/2001	Klaus Schelberger	49651	1391

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KEIL & WEINKAUF  
1350 CONNECTICUT AVENUE, N.W.  
WASHINGTON, DC 20036

EXAMINER

JIANG, SHAOJIA A

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 07/15/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/868,515

Applicant(s)

SCHELBERGER ET AL.

Examiner

Shaojia A. Jiang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

This application is a 371 of PCT/EP99/09803 which claims priority to Germany 198589115.

Applicant's preliminary amendment in Paper No. 15, submitted April 28, 2003 is acknowledged, wherein claims 1, 9, and 10 are cancelled, and claims 11-22 are newly added.

However, it is noted that the numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Since applicant has two claims numbered 11, and the originally presented claim 11 has been cancelled in Paper No. 9 submitted December 2, 2002, the claims herein have been renumbered in accordance with Rule 126, and the dependency of renumbered dependent claims has been completely changed as well. Thus, the claims herein are now numbered 12-23 instead of 11-22.

Currently, claims 12-23 are pending in this application.

It is noted that Applicant's election without traverse of the invention of the species of compounds Ia and II 79, submitted April 30, 2001 in Paper No. 5.

The claims have been examined insofar as they read on the elected specie.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The instant claims are drawn to the employment of a combination of active agents in "a synergistically effective amounts" (see instant claim 11). The instant specification fails to provide information that would allow the skilled artisan to practice the instant invention without undue experimentation. Attention is directed to *In re Wands*, 8 USPQ2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factors to consider when assessing if a disclosure would have required undue experimentation. Citing *Ex parte Forman*, 230 USPQ 546 (BdApl 1986) at 547 the court recited eight factors:

- 1) the quantity of experimentation necessary,
- 2) the amount of direction or guidance provided,
- 3) the presence of absence of working examples,
- 4) the nature of the invention,
- 5) the state of the prior art,
- 6) the relative skill of those in the art

7) the predictability of the art, and

8) the breadth of the claims.

Synergistic or superadditive effects for combinations of compounds are highly unpredictable. In the instant case there is insufficient guidance or working examples in the specification showing amounts and particular agents to be combined which achieve synergistic effects by the fungicidal composition in the method for controlling fungi herein. The declaration of Dr. Eberhard Ammermann submitted January 29, 2002 in Paper No. 5, has been considered but is ineffective to demonstrate any synergistic effects produced by the combination. For example, e.g., on page 4 of this declaration, the degree of the combination of Ia and IIa is 100 which merely shows less than additive effects, compared to the control for Ia and IIa. The evidence in the declaration and specification is not seen to show clear and convincing synergy for any combination of agents within the claims. Therefore, in view of the unpredictability of such synergistically effective amounts of the claimed combination, the guidance in the specification is considered insufficient to show one of skill in the art how to practice the claimed invention without undue experimentation.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwalge et al. (WO 97/06681, of record) and Kasahara et al. (WO 96/19442, of record).

Schwalge et al. (WO 97/06681 equivalent to US 5,972,941) discloses that the particular morpholine, IIa therein, (the elected species, Ia, herein), alone or in combination with the oxime compound of formula I therein in synergistically active amounts is useful in a fungicidal composition and methods for controlling harmful fungi. See US 5,972,941: abstract, col.1 lines 10-55, and the testing at col.5-6. Schwalge et al. also discloses that the mixture therein maybe in two parts wherein one part comprises Compound I therein in a solid or liquid carrier, and the other part comprises the instant particular morpholine a solid or liquid carrier; compound I therein and the instant particular morpholine are applied simultaneously together or separately or successively (see col.2 lines 7-8, col. 3 line 33 to col.4 line 36).

Kasahara et al. (WO 96/19442, equivalent to US 5,847,005) discloses that the particular oxime derivatives such as the elected species, II 79 herein in an effective amount (see Compound 376 in US 5,847,005, col. 21-22), is useful in a fungicidal composition for controlling plant diseases caused by fungi. See WO 96/19442: abstract, and equivalent to US 5,847,005: abstract, col.1 lines 9-36, and col.21-22 and testing in col. 53.

Schwalge et al. and Kasahara et al. do not expressly disclose the employment of the particular oxime derivative, II 79 herein in combination with the particular

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morpholine, Ia herein, in a fungicidal composition and a method for controlling harmful fungi.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the particular morpholine, Ia herein, in combination with the particular oxime derivative, II 79 herein, in a fungicidal composition and a method for controlling harmful fungi.

One having ordinary skill in the art at the time the invention was made would have been motivated to employ the particular morpholine, Ia herein, in combination with the particular oxime derivative, II 79 herein, in a fungicidal composition and a method for controlling fungi, because the particular morpholine, Ia herein, alone or in combination with an oxime compound in effective amounts is known to be useful in a fungicidal composition and a method for controlling fungi based on the prior art. Moreover, the particular oxime derivative, II 79 herein, in an effective amount is known to be useful in a fungicidal composition for controlling plant diseases caused by fungi. Therefore, one of ordinary skill in the art would have reasonably expected that combining Ia herein and II 79 herein known useful for the same purpose in a fungicidal composition would improve the fungicidal effect for controlling fungi in plants.

Since all active composition components herein are known to be useful in a fungicidal composition, it is considered prima facie obvious to combine them into a single composition to form a third composition useful for the very same purpose. At least additive therapeutic effects would have been reasonably expected. See *In re Kerkhoven*, 205 USPQ 1069 (CCPA 1980).

Additionally, the teachings of Schwalge regarding the combination of the particular morpholine herein and the oxime compound therein known to be useful in a fungicidal composition exhibiting synergistic effects against the fungi further provides the motivation to make the present invention.

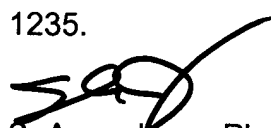
Thus the claimed invention as a whole is clearly prima facie obvious over the combined teachings of the prior art.

In view of the rejections to the pending claims set forth above, no claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.



S. Anna Jiang, Ph.D.  
Patent Examiner, AU 1617  
July 8, 2003